

REMARKS

Reconsideration of the present application is respectfully requested on the basis of the following particulars.

1. Information Disclosure Statement

In the Action, the Examiner failed to consider DE 197 33 662 listed on PTO-1449 form in the information disclosure statement of June 10, 2002 due to an alleged omission of a concise statement of relevancy. Applicant respectfully disagrees with the Examiner's assertion that the information disclosure statement failed to include a concise statement of relevancy since page 1 of the information disclosure statement clearly provides such a statement.

In order to expedite the prosecution of this application and obtain consideration of DE 197 33 662, Applicant submits herewith another information disclosure statement that lists EP 1 002 440 B1 which corresponds to DE 197 33 662 and provides an English translation of the claims. The Examiner is encouraged to review the claims of EP 1 002 440 B1 since they define the inventive features of DE 197 33 662.

In view of the newly submitted documents, consideration of both DE 197 33 662 and EP 1 002 440 B1 is courteously requested in the next Action.

2. Priority

In order to assure the benefit of priority of the pending application from PCT application EP 00/04141 and DE 199 21 524.3, an indication of priority from these applications is provided in the specification. Moreover, an application data sheet is submitted concurrently herewith indicating priority from the aforementioned priority documents.

3. In the Specification

The specification is amended to include proper section headings and to remove reference to the claims. Moreover, a brief description of FIG. 1 is provided in the specification.

It is submitted that the amendment of the specification does not introduce new subject matter into the specification as originally filed. Acceptance of the amendment of the specification is kindly requested in the next Action.

4. In the Abstract

The abstract of the disclosure is amended to correct the informalities identified in the Action. More specifically, the words "invention" and "said" have been removed from the claims, and the abstract has been reduced to a single paragraph. Acceptance of the amendment to the abstract is respectfully petitioned in the next Action.

5. In the Claims

The amendment to the claims have been submitted to improve the clarity of the subject matter for which protection is sought. The changes to the claims were not made to avoid prior art, as it is believed that the original claims are fully patentable over the cited prior art. Rather, in reviewing the claim language it was perceived that some of the language could be improved to more clearly define the inventive subject matter. It is to be noted that the Examiner did not raise any objections with regard to the language of the original claims under 35 U.S.C. § 112 or any other part of the patent laws and regulations.

Claim 9 was specifically amended to make it abundantly clear that information on the first use of the smart is stored in the secret memory area. This amendment makes explicit that which was implicit in the application as originally filed.

It is submitted that the amendment of the claims does not narrow the scope of the subject matter for which protection is sought. Acceptance of the amendment of the claims is respectfully requested in the next Office communication.

6. Rejection of claims 1-4 and 7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,907,804 (Schroderus et al.) in view of U.S. Patent 5,842,124 (Kenagy et al.)

Applicant has carefully considered this rejection but it is most respectfully traversed for the reasons discussed below.

Principally, this rejection is traversed on the basis that the proposed combination of the Schroderus et al. and Kenagy et al. references, whether considered individually or collectively, fail to disclose or suggest the basic method according to claims 1-4 and 7 of the pending application. Moreover, the proposed modification of Kenagy et al. that is advanced in the Action appears to find no basis in the Kenagy et al. reference itself, nor is there any suggestion in the Schroderus et al. reference of the desirability to modify of the teachings described therein in the fashion proposed in the Action.

a. Schroderus et al. reference

The Schroderus et al. reference fails to not only disclose and suggest control of the first use of mobile equipment and the deactivation of an additional application after receiving a confirmation signal, as acknowledged in the Action on page 4, but the Schroderus et al. reference clearly fails to describe providing a request for confirmation whether it is indeed a first use of the mobile equipment.

In the Action, it is asserted that there is a request for confirmation at step 102 in the method of the Schroderus et al. reference, as exemplified in FIG. 1. This assertion is respectfully disputed by Applicant. As is readily apparent, the method of the Schroderus et al. reference requests a PIN code at step 102. According to the

method of FIG. 1, if the PIN code is valid, then protections of the SIM card are released at step 105 and normal operation proceeds at step 106. There is no request for a confirmation of any use of the mobile equipment that is ascertained after a valid PIN code is entered.

Contrary to the Schroderus reference, according to claim 1 of the pending application, a user enters a PIN code and it is only after a first use of the smart card is determined that there is a request for confirmation. Thus, the request for confirmation of a first use is made after a valid PIN code is entered.

There is thus no disclosure or suggestion in the Schroderus et al. reference of the steps of determining a first use of the mobile equipment, requesting for confirmation a first use of the mobile equipment, and deactivating an additional application after the confirmation of a first use is obtained.

b. Kenagy et al. reference

Having made the observations on the shortcomings of the Schroderus et al. reference, the Kenagy et al. reference is thus faced with the task of remedying the deficiencies of the Schroderus et al. reference. Applicant submits that the Kenagy et al. reference fails to make up for these shortcomings on the basis of the following observations.

First, it is clear that the Kenagy et al. reference does not describe a self-contained smart card having an additional application that makes a determination of a first use. Instead, the Kenagy et al. reference describes calling a service provider to obtain a temporary password which is input to gain access to a network (col. 8, lines 37-42). Conversely, according to claim 1 of the pending application, a user enters a PIN code of which is read by an additional application of the smart card. It is the additional application and not a service provider which makes the determination of a first use of the smart card for a network communication.

Next, the Kenagy et al. reference fails to disclose or suggest requesting a confirmation of a first use. Rather, once a user has successfully programmed all required parameters, there is a merely confirmation message on a display that confirms successive programming of the parameters (col. 8, lines 21-25). There does not appear to be any teaching of requiring the user to confirm a first user in the Kenagy et al. reference. On the contrary, claim 1 of the pending application provides a request for confirmation and subsequently acts upon this request.

Third, it follows from the failure of the Kenagy et al. reference to describe a request for confirmation that this prior art reference equally fails to deactivate an additional application. As an alternative, the Kenagy et al. reference simply decrements an attempt counter to zero once all of a plurality of parameters are successively programmed (col. 8, lines 62-63). These passwords may be used one or more times and there is a plurality of different passwords stored (col. 7, line 59 through col. 8, line 8). Claim 1 of the pending application proffers a substantially simpler method wherein the additional application is merely concerned with successful entry of the PIN code to determine whether there is a first use.

Due to the multiplicity of passwords employed in the method of the Kenagy et al. reference, it is clear that repeated usage is envisioned and thus there is no deactivation of an additional application, as recited in claim 1 of the pending application.

Lastly, it is respectfully disputed that the evidence provided to support the assertion that the Kenagy et al. reference makes up for the acknowledged shortcomings of the Schroderus et al. reference. The Kenagy et al. reference clearly fails to make an indication of first use. Instead, it merely resets a counter once a successful password is entered. As noted above, the passwords may be used numerous times and are not specifically related to making a determination of first use and the algorithm which is used to determine a successful password is used

irrespective of first use. In fact, there is no indication in the Kenagy et al. reference of making a determination of first use and then acting accordingly to obtain a confirmation of first use.

c. Combination of the Schroderus et al. and Kenagy et al. references

While it is argued that the Schroderus et al. reference could be modified in view of the teachings of the Kenagy et al. reference, the Kenagy et al. reference is subsequently modified in the Action in order to overcome its own limitations. The basis for this modification of the Kenagy et al. reference simply does not appear to be rooted in the reference itself.

The proposed modification of the Kenagy et al. reference appears to be based on general knowledge. When general knowledge is relied upon to negate patentability, it is well established by the courts that the knowledge must be articulated in the record and cannot be resolved on "subjective belief and unknown authority." The Action thus attempts to overcome the deficiencies of both the Schroderus et al. and Kenagy et al. references based on the very subjective belief and unknown authority prohibited by the courts.

Evidence of the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Both of the Schroderus et al. and Kenagy et al. references fail to provide any suggestion of making the specific determination of a first use and then acting accordingly, as recited in claim 1. Moreover, the Action does not proffer any evidence which would support the proposed modification of either of the references to arrive at the method of claim 1.

d. Conclusion

In accordance with the aforementioned observations, it is respectfully submitted that claim 1 of the pending application is not rendered obvious by the proposed combination of the Schroderus et al. and Kenagy et al. references. Thus, claim 1 is patentable. Claims 2-4 and 7, which depend from claim 1, are thus patentable based on their dependency from claim 1 and their individually recited features. Withdrawal of this rejection is therefore respectfully requested.

7. Rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,907,804 (Schroderus et al.) in view of U.S. Patent 5,842,124 (Kenagy et al.) and further in view of U.S. Patent 5,757,918 (Hopkins)

This rejection is respectfully traversed on the basis that the Hopkins reference fails to make up for the aforementioned shortcomings of the Schroderus et al. and Kenagy et al. references regarding the rejection of claim 1. Claim 5, which depends from claim 1, is thus patentable based on its dependency from claim 1 and its individually recited features.

Accordingly, withdrawal of this rejection is kindly requested.

8. Rejection of claims 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,907,804 (Schroderus et al.) in view of U.S. Patent 5,842,124 (Kenagy et al.) and further in view of U.S. Patent 6,314,519 (Davis et al.)

This rejection is respectfully traversed on the basis that the Hopkins reference fails to make up for the aforementioned shortcomings of the Schroderus et al. and Kenagy et al. references regarding the rejection of claim 1. Claims 6 and 8, which depend from claim 1, are thus patentable based on their dependency from claim 1 and their individually recited features.

Accordingly, withdrawal of this rejection is courteously requested.

9. Rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,012,634 (Brogan et al.) in view of U.S. Patent 5,842,124 (Kenagy et al.)

Applicant has carefully considered this rejection but it is most respectfully traversed for the reasons discussed below.

It is readily acknowledged in the Action that the Brogan et al. reference fails to teach a memory where an application for the execution control of the first use of the smart card is stored and a secret memory area where data on the application are stored in protected fashion.

The shortcomings of the Kenagy et al. reference are enumerated above in reference to the basic features of claim 1. Turning specifically to the smart card recited in claim 9 of the pending application, it is readily clear in view of the aforementioned discussion of the Kenagy et al. reference that there is not a specific determination as to the first use of the smart card.

It thus follows that the Kenagy et al. reference does not provide any suggestion to save information on the first use of a smart card in a secret memory area. While the Action interprets a "stored password" as being stored in a "protected area" of memory such that a user cannot access it in the Kenagy et al. reference, it was pointed out above that the passwords of the Kenagy et al. reference are not related to a first use and moreover can be used repeatedly (col. 7, lines 64-66).

According to claim 9, in contrast to a PIN code that is usually recorded in a secret or inaccessible memory area, the information on the first use of a card does not serve to prevent the illegitimate usage of network for communication, but merely serves to indicate to the legitimate user either that he uses the card for the first time, or if the card was used illegitimately before and that he is not the first user of the

card. This is a distinction that the Action fails to factor in the rejection of claim 9 and is a substantial distinction of the pending application over the proposed combination of the Brogan et al. and Kenagy et al. references.

Thus, it is submitted that the Brogan et al. and Kenagy et al. references, whether considered collectively or individually, fail to disclose or suggest the smart card recited in claim 9 of the pending application. Thus, claim 9 is patentable.

Withdrawal of the rejection of claim 9 is therefore requested.

10. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that each and every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Phone: (703) 683-0500

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Respectfully submitted,



JUSTIN J. CASSELL
Attorney for Applicant
Registration No. 46,205